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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,898	02/17/2004	Joseph Wyss	1671-0302	9614

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EXAMINER

SWEET, THOMAS

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/779,898	<b>Applicant(s)</b> WYSS, JOSEPH	
	<b>Examiner</b> Thomas J Sweet	<b>Art Unit</b> 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9-21 and 23-28 is/are rejected.
- 7) ☒ Claim(s) 3,8 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/17/2004</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Specification***

The abstract of the disclosure is objected to because it is in excess of 150 words.

Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-5, 7, 9-21, 23 and 25-28 and are rejected under 35 U.S.C. 102(b) as being anticipated by Bahler (US 5395401). Bahler discloses a joint prosthesis (fig. 21), comprising: a femoral component 2119 having first condylar articular surface, a second condylar articular surface, and an intercondylar recess interposed therebetween (2138 as seen in fig. 23); a tibial component (2113, 2115 and 2117) having a bone engaging portion 2125 and defining a connection bore 31; a meniscal component (2113 and 2115) having a stem 33 positioned within

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said connection bore 31 of said tibial component so as to rotatably mount said meniscal component to said tibial component, and further having a first bearing surface and a second bearing surface (both labeled as 2121) spaced apart from each other so as to define a channel 37, said stem being fixed (in the vertical plane by dovetailed member 2116 in channel 37) in relation to said first bearing surface and said second bearing surface; and a stabilizing post slidably 2136 mounted (by 2116) within said channel 37 of said meniscal component, said post projecting into said intercondylar recess (see figs. 23 and 24) when said first condylar articular surface and said second condylar articular surface are respectively positioned in contact with said first bearing surface and said second bearing surface.

With respect to claims 2, 4, 19 and 20, the locking member (the dovetailed portion of 2116) is configured to mount in the open end at 2135 and can be said to press-fit within the channel.

With respect to claims 5, 7, 18, 21 and 23, the base of the post 2136 is configured (dovetailed) for sliding engagement within the pair of grooves one on each side of the channel and the dovetails function as a locking component (against vertical movement).

With respect to claims 9 and 25, figures 28a - 28c shows selectable array of stabilizing posts.

With respect to claims 10-12 and 26-28, as seen in figures 23 and 24 the recess includes surfaces at opposite ends and faces on each side of the post (differently curved) which are configured to provide camming movement of the respective sides. Additionally, see fig. 28b which is configured with surfaces similar to the applicants.

With respect to claim 16, Bahler discloses a joint prosthesis (fig. 21) comprising: a first joint component 2119 having a bone engaging portion 2156, an articular surface 2111, and a recess (2138 as seen in fig. 23) defined within said articular surface; a mating component (2113, 2115 and 2117) having a bone engaging portion 2125 and defining a bearing surface 2121 for sliding contact with said articular surface of said first joint component', and a stabilizing post 2136 slidably mounted (by 2116) to said mating component amid said bearing surface, said post projecting from said mating component and into said recess when said articular surface is in contact with said bearing surface, wherein said mating component (2113, 2115 and 2117) includes (i) a second joint component including the bone engaging portion 2125; and (ii) an intermediate component (2113 and 2115) connected to said second joint component, said intermediate component including said bearing surface 2121, wherein said second joint component defines a bore 31; and wherein said intermediate component includes a pin 33 sized to be received within said bore, and wherein said pin is fixed (in the vertical plane by dovetailed member 2116 in channel 37) in relation to said bearing surface.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bahler. Bahler discloses a joint prosthesis as

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discussed above. As shown in figure 21, the base is shorter than the length of the channel.

However, if this is not the case, since the base slides within the channel beyond the constraints of the channel as seen in figures 23 and 24, the length is arbitrary. Resizing components is an obvious variation within the skill level of one of ordinary skill in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the length of the base so as to be shorter than the length of the channel because such a modification would have been considered a mere design choice which fails to patentably distinguish over the prior art of Bahler.

#### ***Allowable Subject Matter***

Claims 3, 8 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Colleran et al (US 5776201).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J Sweet whose telephone number is (703) 308-4018. The examiner can normally be reached on 6:30 am - 5:00pm, M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M McDermott can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tjs



David H. Willse  
Primary Examiner